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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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32233	7590	06/26/2006	EXAMINER	
STORM L.L.P. BANK OF AMERICA PLAZA 901 MAIN STREET, SUITE 7100 DALLAS, TX 75202			PECHHOLD, ALEXANDRA K	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/723,968	Applicant(s) RIKER, RONALD D.	
	Examiner Alexandra K. Pechhold	Art Unit 3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-5, 7-11, 13-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hubbell et al (US 6,409,433) in view of Kubicky (US 6,322,863).**

Regarding claim 1, Hubbell discloses a post capable of being used adjacent roadways for supporting an object, comprising:

- a hollow sleeve of polymeric resin, seen as the shell of epoxy resin (7) (since epoxy can be polymeric), and having an interior surface and an exterior surface, the exterior surface of the sleeve defining an exterior of the post (if one views the “post” of Hubbell as the structure including the shell 7 and the material within);
- one end of the sleeve being capable of being received in and supported by a ground surface, and an opposite end of the sleeve extending from the ground surface and being capable of being secured to the object, since it has been held that the recitation than an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform; it does not constitute a limitation in any patentable sense (*In re Hutchison*, 69 USPQ 138);

- a core within the sleeve, seen as structural tubular element (4), seen as coextensive with and secured to the interior of the sleeve, and can be made of rubber (Col 6, line 8), wherein the core and sleeve are continuous along the post from one end to the opposite end, as seen in Fig. 2.

Hubbell fails to disclose a majority of the post extends from the ground surface. The post of Hubbell is designed to be a pile and/or load carrying element designed for marine environments. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the pile of Hubbell to have a majority of the post extending from the ground surface if the application of the post to a particular use and environment deems that a majority of the post extending from the ground surface provides a more structurally sound, efficient, economical, or otherwise advantageous design.

Hubbell also fails to disclose the rubber in element (4) as having a recycled rubber component thereto. Kubicky teaches using recycled scrap tires for a utility pole, thereby providing a use for disposed scrap tires, saving forests, and do not have the environmental and structural problems of creosote covered wooden poles, aluminum poles, or concrete poles (Col 2, lines 1-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the rubber of Hubbell to have a recycled rubber component as taught by Kubicky, since Kubicky notes the environmental advantages of reusing discarded tires in column 2, lines 1-16.

Regarding claim 9, Hubbell discloses the limitations of the claimed invention as discussed with respect to claims 1 and 2 above.

Hubbell fails to disclose a majority of the sleeve length extending from the ground

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surface. The post of Hubbell is designed to be a pile and/or load carrying element designed for marine environments. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the pile of Hubbell to have a majority of the post extending from the ground surface if the application of the post to a particular use and environment deems that a majority of the post extending from the ground surface provides a more structurally sound, efficient, economical, or otherwise advantageous design.

Hubbell also fails to disclose the rubber in element (4) as having a 10% recycled rubber component thereto. Kubicky teaches using recycled scarp tires for a utility pole, thereby providing a use for disposed scrap tires, saving forests, and do not have the environmental and structural problems of creosote covered wooden poles, aluminum poles, or concrete poles (Col 2, lines 1-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the rubber of Hubbell to have a recycled rubber component as taught by Kubicky that is 10% by weight recycled rubber, since Kubicky notes the environmental advantages of reusing discarded tires in column 2, lines 1-16, and it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claims 16 and 18, Hubbell discloses a sleeve with a circular cross section, and a core coextensive with the sleeve interior as discussed with regards to claim 1 above and seen in Figs. 1 and 2. Hubbell discloses the core (4) as plastic (Col 6, line 8), thereby meeting the polymer limitation. Hubbell fails to disclose the core (4) being at least 10% or 20% by weight recycled crumb rubber and the balance as a low-melt index polyethylene, though Hubbell does disclose that core (4) can be made of various materials, such as plastic and rubber (Col 6, lines 7-

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9), and polyethylene is a type of plastic. Hubbell fails to disclose that layer (7) is high-density polyethylene, instead disclosing that (7) “can be composed for resin, for example epoxy resin and the like.” (Col 6, lines 29-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the layer (7) of Hubbell to be high density polyethylene, since Hubbell broadly discloses that the layer (7) may be a type of resin “and the like”, which has the similar advantageous structural and durability qualities of high density polyethylene. Kubicky teaches using recycled scarp tires for a utility pole, thereby providing a use for disposed scrap tires, saving forests, and do not have the environmental and structural problems of creosote covered wooden poles, aluminum poles, or concrete poles (Col 2, lines 1-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the rubber and plastic core of Hubbell to have a recycled component thereto as taught by Kubicky, and having at least 10% or 20% by weight recycled rubber, since Kubicky notes the environmental advantages of reusing discarded materials in column 2, lines 1-16, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). Hubbell furthermore fails to disclose a majority of the sleeve length extending from the ground surface. The post of Hubbell is designed to be a pile and/or load carrying element designed for marine environments. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the pile of Hubbell to have a majority of the post extending from the ground surface if the application of the post to a particular use and environment deems that a majority of the post extending from the ground surface provides a more structurally sound, efficient, economical, or otherwise advantageous design.

Regarding claims 2, 15, and 20, Figs. 1 and 2 of Hubbell illustrate the (7) and (4) as circular and (4) as hollow.

Regarding claims 3 and 10, Hubbell fails to disclose that (7) is high density polyethylene, instead disclosing that (7) “can be composed for resin, for example epoxy resin and the like.” (Col 6, lines 29-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the layer (7) of Hubbell to be high density polyethylene, since Hubbell broadly discloses that the layer (7) may be a type of resin “and the like”, which has the similar advantageous structural and durability qualities of high density polyethylene.

Regarding claims 4, 5, and 11, Hubbell discloses that core (4) can be composed of various materials, such as concrete, plastic, rubber, structural foam, etc. (Col 6, lines 7-9), which therefore could include a combination of rubber and thermoplastic resin. Hubbell does not disclose that any of these materials are recycled, nor having a certain percentage (10% or 20%) of recycled rubber. Kubicky teaches using recycled scarp tires for a utility pole, thereby providing a use for disposed scrap tires, saving forests, and do not have the environmental and structural problems of creosote covered wooden poles, aluminum poles, or concrete poles (Col 2, lines 1-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the rubber and thermoplastic core of Hubbell to have a recycled component thereto as taught by Kubicky, and having the mixture comprise 10% or 20% by weight recycled rubber, since Kubicky notes the environmental advantages of reusing discarded materials in column 2, lines 1-16, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

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Regarding claims 8, 14, and 17, Hubbell fails to disclose the post having crash properties conforming to NCHRP Report 350. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the post of Hubbell to have crash properties conforming to NCHRP Report 350, since the applicant states in the specification that the standards have been adopted by most states.

Regarding claims 7 and 13, Hansen fails to disclose the sleeve and core as coextruded, instead forming and attaching the layer (7) to the inner core (4) (Col 6, lines 43-57). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the means by which the core and layer of Hansen are made and joined so that they are coextruded, since either process would still result in the same finished product with the layer (7) being joined directly against the core (4) with no disjunction or disjointedness, since the Figures show a direct continuous interface between these layers.

3. **Claims 6, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hubbell et al (US 6,409,433) and Kubicky (US 6,322,863) as applied to claims 1, 9, and 16, respectively above, and further in view of Hansen (US 2003/0072904).** The combination of Hubbell and Kubicky fails to disclose a highway sign of an area of less than 10 sq. ft. Hansen teaches a utility pole, guardrail, a signpost, and may be suitable for many other construction applications (para. 20), much like the pile structure of Hubbell. Hansen fails to disclose the area of the signpost. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hubbell to support a signpost as taught by Hansen, since Hansen states in para. 20 the multiple uses of such a pole or post, such as supporting a sign, and with

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respect to the 10 sq. ft size, discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

4. Applicant's arguments filed 6/5/06 have been fully considered but they are not persuasive. The Examiner maintains the rejection using the same prior art.


With respect to the applicant's amendments, the Examiner is viewing the recited "post" as the structure (7) in Hubbell and the area within, not taking into account the outer friction coating, since this is simply an outer surface of sand or friction imparting particles (Col 6, lines 32-42). Even if one were to argue that this interpretation destroys the reference by taking a piecemeal approach to viewing the art, the Examiner would argue that this exterior coating could simply be a dusting of sand or particles, and therefore this could still leave portions of (7) still exposed as the exterior surface of the post.

The applicant argues that there is no mutation to substitute recycled rubber for the disclosed rubber "layer" of Hubbell. The Examiner disagrees, since Kubicky is only demonstrative of the many uses of recycled rubber. For example, it is well known that scrap tires are recycled and reused in other products as one many environmentally conscious ways to reuse rubber.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexandra Pechhold whose telephone number is (571) 272-6994. The examiner can normally be reached on Mon-Thurs. from 8:00am to 5:30pm and alternating Fridays from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached on (571) 272-6998. The fax phone number for this Group is (571) 273-8300.


Alexandra Pechhold
Patent Examiner
Group 3600

AKP
6/16/06